

THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: June 20, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Templer

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Serial No. 76577262

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Myron Amer of Myron Amer, P.C. for Lazar Templer.

Ellen J.G. Perkins, Trademark Examining Attorney, Law  
Office 100 (Chris A.F. Pedersen, Managing Attorney).

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Before Hohein, Grendel and Cataldo, Administrative  
Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Lazar Templer to register  
the mark PRIMA-CARE on the Principal Register for "medical  
supplies, such as gauze pads, and related goods."<sup>1</sup>

The trademark examining attorney initially required  
applicant to clarify or limit the identification of goods  
to goods that fall within the scope of those goods set  
forth originally in the application, in accordance with

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<sup>1</sup> Application Serial No. 76577262, filed February 23, 2004, based  
on applicant's allegation of a bona fide intent to use the mark  
in commerce under Section 1(b) of the Trademark Act.

Trademark Rule 2.71(a), by substituting more definite language for the wording "such as" and "related goods."

In response thereto, applicant requested that the identification of goods be amended to read "gauze of cloth" in International Class 24.

In the second Office action, the examining attorney rejected the proposed amendment to the identification of goods, and made final the requirement that applicant submit an amendment that falls within the scope of the goods as originally identified.

In response thereto, applicant requested that the identification of goods be amended to read "cloth gauze" in International Class 24.

When the examining attorney rejected the second proposed amendment and continued the final requirement that applicant submit an acceptable amendment to the identification of goods, applicant appealed. Applicant and the examining attorney filed main briefs and applicant filed a reply brief.

Applicant argues that his proposed amendment to the identification of goods eliminates the wording deemed indefinite by the examining attorney; and that the proposed amendment thus complies with the examining attorney's requirement for a more definite identification of goods.

Applicant further argues that he is a manufacturer of all-purpose gauze cloth; and that the examining attorney's suggestion of prefacing applicant's amended recitation with the wording "medical supplies, namely," would, in essence, render inaccurate the identification of goods.

The examining attorney maintains that the prefatory wording in the original identification of goods clearly indicates that applicant provides goods in the medical field; that elimination of the indefinite wording from the original identification of goods leaves "gauze pads," which is an acceptable identification of medical goods in International Class 5; and that applicant's proposed amendment to "gauze cloth," however, falls outside the scope of the goods as originally identified.

Applicant contends in reply that the issue on appeal is whether his goods, identified as "cloth gauze," fall outside the scope of the goods as previously amended, namely, "gauze of cloth." Applicant further contends that the authority relied upon by the examining attorney does not support the requirement at issue on appeal.

We turn then to our determination with regard to applicant's proposed amendment to his identification of goods. Section 7(c) of the Trademark Act provides, in part, as follows:

Contingent on the registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration...

15 U.S.C. §1057. Thus, the identification of goods or services in an application defines the scope of those rights established by the filing of an application for registration on the Principal Register. See TMEP §1402.06 (2d ed. rev. April 2005). An applicant may not expand those rights through amendment of the identification of goods or services. See TMEP §1402.06(b) (2d ed. rev. April 2005).

In accordance therewith, amendments to the identification of goods or services are governed by Trademark Rule 2.71(a), which provides as follows: "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." 37 C.F.R. §2.71(a). Accordingly, an applicant may not amend an identification of goods or services to add or substitute a term that is not logically included within the scope of the terms originally identified or that is otherwise qualitatively different from the goods and services as originally identified. See TMEP §1402.06(a)

(2d ed. rev. April 2005). In addition, TMEP §1402.07(d)

(2d ed. rev. April 2005) provides, in part, as follows:

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language of the identification before the proposed amendment.

Thus, the scope of the goods or services as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments.<sup>2</sup> See TMEP §1402.07 (2d ed. rev. April 2005).

In this case, applicant's goods were originally identified in his application as "medical supplies, such as gauze pads, and related goods." As noted by the examining attorney, the wording "such as" and "related goods" is indefinite. See TMEP §1402.03(a) (2d ed. rev. April 2005). Nonetheless, the goods clearly encompass medical supplies, including gauze pads. In accordance with the above authorities, applicant is limited in any proposed amendment

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<sup>2</sup> Contrary to applicant's assertion in his reply brief, we need not determine whether "cloth gauze" falls within the scope of applicant's previous amendment to his identification of goods, namely, "gauze of cloth," inasmuch as that earlier proposed amendment was rejected by the examining attorney in her final Office Action. See TBMP §1402.07(d), *supra*.

to his identification of goods solely to narrowing or clarifying the originally recited medical supplies. Applicant's proffered amendment of his identification of goods to "cloth gauze" falls outside the scope of the original. Applicant explains his proposed amendment by asserting in his response to the first Office Action that the recited goods were "inadvertently misdescribed as filed and should have been for a piece goods component used for children's hats." However, applicant cites to no authority to support his contention that the inadvertent misdescription of the goods in his application can be corrected by amending his goods to fall outside the scope of the original. To the contrary, it is settled that once the extent of an identification has been established, it cannot be expanded later. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); and *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). In this case, the wording "medical supplies" establishes the parameters of applicant's identification of goods. Applicant therefore is limited in any amendment solely to narrowing or clarifying the nature and type of the applied-for "medical supplies" with greater particularity. See TMEP §1402.03(a), *supra*. Inasmuch as the proposed

Ser No. 76577262

identification of goods neither narrows nor clarifies the original identification of goods, it was properly rejected.<sup>3</sup>

**Decision:** The refusal to register is affirmed.

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<sup>3</sup> Applicant's remedy, in the event he seeks to register his mark for "cloth gauze," is to file a new application for such goods.